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10/588,065	05/02/2007	Masataka Suguri	2006_1231A	4346
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WENDEROTH, LIND & PONACK, L.L.P. 1030 15th Street, N.W., Suite 400 East Washington, DC 20005-1503			NGUYEN, CHAUT	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/588,065	<b>Applicant(s)</b> SUGIURA ET AL.
	<b>Examiner</b> CHAU NGUYEN	<b>Art Unit</b> 2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 01 August 2006.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-12 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 01 August 2006 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-166/08)  
 Paper No(s)/Mail Date 08/01/2006
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_

**DETAILED ACTION**

1. Claims 1-12 are pending.

**Notes**

2. Claim 1 recites a content creation "apparatus" comprising steps of processing data. In the Specification, paragraph [0076] describes "In the embodiment, the content creation apparatus 10 is a cellular telephone and a personal digital assistance, for example." That means the content creation "apparatus" is hardware per se. Therefore, claim 1 is statutory subject matter.
3. Claim 1 recites a content creation apparatus comprising means plus function, but this means plus function is in the form "means which", which is not considered the same as "means for" or "step for". Since 35 U.S.C. 112, sixth paragraph will be invoked if a claim limitation meets the following 3-prong analysis:

- (A) the claim limitations must use the phrase "means for" or "step for,"
- (B) the "means for" or "step for" must be modified by functional language; and
- (C) the phrase "means for" or "step for" must not be modified by sufficient structure, material, or acts for achieving the specified function.

With respect to the first prong of this analysis, claim 1 of the instant application does not include the phrase "means for" or "step for", and therefore claim 1 will not be considered to invoke 35 U.S.C 112, sixth paragraph (see MPEP, section 2181[R-6]).

4. Similarly, Claims 2-10 recite "means" but do not use the phrase "means for" or "step for," and therefore claims 2-10 will no be considered to invoke 35 U.S.C 112, sixth paragraph.

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claim 12 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In summary, Claim 12 recites a "program" which creates multimedia contents, the "program" allowing a computer to implement processes. Since "allowing a computer" does not necessarily mean to include a computer (hardware), thus the program of Claim 12 is software *per se*.

Accordingly, the recited "program" is computer software *per se* and is not a "process," a "machine," a "manufacture" or a "composition of matter," as defined in 35 U.S.C. 101. Therefore, Claim 12 is not statutory subject matter.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 1-8 and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sudoh et al. (Sudoh), US Patent Application Publication No. 2006/0053468 A1 and further in view of Iijima, US Patent No. 7,466,349.

9. As to independent claim 1, Sudoh discloses a content creation apparatus comprising:

a playback means which plays back a multimedia template into which media data can be inserted (col. 8, paragraph [0163], Figures 70-71 and 72A-72D: image file, text file and music data file are inserted in to a template, and the template is displayed for playing back or reproducing);

a media data accepting means which accepts a user's instruction relating to selection of media data to be inserted into the multimedia template (page 5, paragraph [108] and Figures 70-71 and 72A-72D shows a display screen accepting user inputs such as selecting photo image and entering a text message into the template);

a control means which inserts media data selected through the media data accepting means to the multimedia template and allows the playback means to play back the multimedia template (col. 8, paragraph [0163] and Figures 70-71 and 72A-75D: the photo message 20030819.jpg and the message "Congratulation" are inserted into the template for displaying or playing back);

a multimedia content creating means which creates multimedia contents based on the multimedia template and confirmed media data in accordance with confirmation of the media data selected through the media data accepting means (col. 8, paragraph [0163] and Figures 70-71 and 72A-75D: after inserting the photo image and the text message into the template, and when the user clicks or selects "send" on the template, the inserted files are incorporated into the template and displayed or played back).

Sudoh discloses a function of stopping the reproduction at a point in time when a user shows an intention to edit (page 22, paragraph [0360]). Sudoh, however, does not explicitly disclose media data to be inserted into the multimedia template during playback of the multimedia template by the playback means.

Iijima discloses determining a moving image insert mode is set, a moving image data is selected begins to be played back, and checking whether or not the user has given an insert mark that designated an insert timing in the middle of the moving image, whose playback and display are in progress (Abstract and col. 6, lines 1-17).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Iijima with Sudoh to include media data to be inserted into the multimedia template during playback of the multimedia template by the playback means for the purpose of providing editing or modification to media data while it is playing back.

10. As to dependent claim 2, Sudoh discloses wherein the playback means stops playback of the multimedia template from time when a user instructs starting selection

of media data to time when selection of media data is completed (page 8, paragraphs [0160]-[0163]: after the start of implementation of the script in the template, the still image top.jpg and text top.txt are displayed for 0 to 2 second and still image image.jpg, music data bgm.amr and text message.text are reproduced for 2-8 seconds and then stop).

11. As to dependent claim 3, Sudoh discloses a means which encourages a user to select media data relating to a time period to allow insertion (page 2, paragraph [0021], page 8, paragraphs [0160]-[0163] and Figures 70 and 72A-D: Figure 70 shows a script of a template includes two scenes, first scene displays an image top.jpg and a text message top.txt for 2 seconds (from 0 second to 2<sup>nd</sup> second), second scene displays image.jpg, audio bgm.amr, and text message.txt for 6 seconds (from 2nd second to 8th second), Figure 72 shows a user inputs by selecting a photo 20030829.jpg and message text "Congratulations!" for the slots image.jpg and message.txt, respectively, and the template when is executed, the top.jpg and top.txt are displayed for 2 seconds, and the photo 20030829.jpg, audio bgm.amr and the message "Congratulations!" are displayed for 6 seconds).

Sudoh, however, does not explicitly disclose media data to be inserted into the multimedia template during playback.

Iijima discloses determining a moving image insert mode is set, a moving image data is selected begins to be played back, and checking whether or not the user has

given an insert mark that designated an insert timing in the middle of the moving image, whose playback and display are in progress (Abstract and col. 6, lines 1-17).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Iijima with Sudoh to include media data to be inserted into the multimedia template during playback for the purpose of providing editing or modification to media data while it is playing back.

12. As to dependent claim 4, Sudoh discloses wherein the means which encourages selection stops playback of the multimedia template at time to start the time period to allow insertion (page 8, paragraph [0159], page 22, paragraphs [0360]-[0361] and Figure 53: stopping the reproduction (playback) at a point in time when a user shows an intention to edit, and the start of the scene at the time of reproduction when the scene is stopped for carrying out an editing scene, and Figure 53 shows editing such as inserting an image file from a list of image files).

13. As to dependent claim 5, Sudoh discloses wherein the means which encourages selection presents a user that it is a time period to allow accepting selection of media data during the time period to allow insertion (page 2, paragraph [0021], page 8, paragraphs [0160]-[0163] and Figures 70 and 72A-D: Figure 70 shows a script of a template includes two scenes, first scene displays an image top.jpg and a text message top.txt for 2 seconds (from 0 second to 2<sup>nd</sup> second), second scene displays image.jpg, audio bgm.amr, and text message.txt for 6 seconds (from 2nd second to 8th second),

Figure 72 shows a user inputs by selecting a photo 20030829.jpg and message text "Congratulations!" for the slots image.jpg and message.txt, respectively, and the template when is executed, the top.jpg and top.txt are displayed for 2 seconds, and the photo 20030829.jpg, audio bgm.amr and the message "Congratulations!" are displayed for 6 seconds).

14. As to dependent claim 6, Sudoh discloses wherein the means which encourages selection displays information about potential media data to be selectable on a screen (Figures 72A-72B show a user selects photo image from the browser button, which means when the user clicks on the browser button, it will display a list of images of photos that allow the user to choose or select from).

15. As to dependent claim 7, Sudoh discloses wherein the playback means displays an area into which media data is inserted as an image on a multimedia template that is being played back (page 7, paragraph [0151] – page 8, paragraph [0156] and Figures 6-8, 81-82: Figure 7 shows FirstImage.mpg data, FirstText.txt data and FirstSound.smf data are reproduced between the 0th second and the 8<sup>th</sup> second when the button "MOVIE STARTUP" is selected, and each of the data is displayed in an area such as x,y,w,h described in Figure 81).

16. As to dependent claim 8, Sudoh discloses wherein the media data accepting means accepts insertion of media data into the insertion area in accordance with

selection of an image in the insertion area displayed in the insertion area (Figures 72—72B: the user inserts the photo image on the top of the template and enters text message on the bottom of the template).

17. As to dependent claim 10, Sudoh discloses wherein the media data accepting means can accept an instruction to use a moving picture or a still image that is being shot by an image pickup means as media data to be inserted into the multimedia template (page 23, paragraph [0376] and Figures 52A-52C: an image is taken by a camera, the image is inserted into the template and may be displayed for a predetermined period of time).

18. As to independent claim 11, Sudoh discloses a content creation method comprising steps of:

playing back a multimedia template into which media data can be inserted (col. 8, paragraph [0163], Figures 70-71 and 72A-72D: image file, text file and music data file are inserted in to a template, and the template is displayed for playing back or reproducing);

accepting an input of a user's instruction relating to selection of media data to be inserted into the multimedia template (page 5, paragraph [108] and Figures 70-71 and 72A-72D shows a display screen accepting user inputs such as selecting photo image and entering a text message into the template);

inserting media data selected by the inputted user's instruction to the multimedia template and playing back the multimedia template (col. 8, paragraph [0163] and Figures 70-71 and 72A-75D: the photo message 20030819.jpg and the message "Congratulation" are inserted into the template for displaying or playing back); and

creating multimedia contents based on the multimedia template and confirmed media data in accordance with confirmation of the media data selected by the inputted user's instruction (col. 8, paragraph [0163] and Figures 70-71 and 72A-75D: after inserting the photo image and the text message into the template, and when the user clicks or selects "send" on the template, the inserted files are incorporated into the template and displayed or played back).

Sudoh discloses a function of stopping the reproduction at a point in time when a user shows an intention to edit (page 22, paragraph [0360]). Sudoh, however, does not explicitly disclose media data to be inserted into the multimedia template during playback of the multimedia template by the playback means.

Iijima discloses determining a moving image insert mode is set, a moving image data is selected begins to be played back, and checking whether or not the user has given an insert mark that designated an insert timing in the middle of the moving image, whose playback and display are in progress (Abstract and col. 6, lines 1-17).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Iijima with Sudoh to include media data to be inserted into the multimedia template during playback of the multimedia template

by the playback means for the purpose of providing editing or modification to media data while it is playing back.

19. As to independent claim 12, Sudoh discloses a program which creates multimedia contents, the program allowing a computer to implement processes of:

playing back a multimedia template into which media data can be inserted (col. 8, paragraph [0163], Figures 70-71 and 72A-72D: image file, text file and music data file are inserted in to a template, and the template is displayed for playing back or reproducing);

accepting an input of a user's instruction relating to selection of media data to be inserted into the multimedia template (page 5, paragraph [108] and Figures 70-71 and 72A-72D shows a display screen accepting user inputs such as selecting photo image and entering a text message into the template);

inserting media data selected by the inputted user's instruction to the multimedia template and playing back the multimedia template (col. 8, paragraph [0163] and Figures 70-71 and 72A-75D: the photo message 20030819.jpg and the message "Congratulation" are inserted into the template for displaying or playing back); and

creating moving picture contents based on the multimedia template and confirmed media data in accordance with confirmation of the media data selected by the inputted user's instruction (col. 8, paragraph [0163] and Figures 70-71 and 72A-75D: after inserting the photo image and the text message into the template, and when the

user clicks or selects "send" on the template, the inserted files are incorporated into the template and displayed or played back).

Sudoh discloses a function of stopping the reproduction at a point in time when a user shows an intention to edit (page 22, paragraph [0360]). Sudoh, however, does not explicitly disclose media data to be inserted into the multimedia template during playback of the multimedia template by the playback means.

Iijima discloses determining a moving image insert mode is set, a moving image data is selected begins to be played back, and checking whether or not the user has given an insert mark that designated an insert timing in the middle of the moving image, whose playback and display are in progress (Abstract and col. 6, lines 1-17).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Iijima with Sudoh to include media data to be inserted into the multimedia template during playback of the multimedia template by the playback means for the purpose of providing editing or modification to media data while it is playing back.

20. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sudoh and Iijima as applied to claims 1-8 and 10-12 above, and further in view of Ishii, US Patent Application Publication No. 2003/0016947.

21. As to dependent claim 9, Sudoh and Iijima disclose allowing insertion of media data to time to accept media data by the media data accepting means (Sudoh, page 2,

paragraph [0021], page 8, paragraphs [0160]-[0163] and Figures 70 and 72A-D: Figure 70 shows a script of a template includes two scenes, first scene displays an image top.jpg and a text message top.txt for 2 seconds (from 0 second to 2<sup>nd</sup> second), second scene displays image.jpg, audio bgm.amr, and text message.txt for 6 seconds (from 2nd second to 8th second), Figure 72 shows a user inputs by selecting a photo 20030829.jpg and message text "Congratulations!" for the slots image.jpg and message.txt, respectively, and the template when is executed, the top.jpg and top.txt are displayed for 2 seconds, and the photo 20030829.jpg, audio bgm.amr and the message "Congratulations!" are displayed for 6 seconds).

Sudoh and Iijima, however, do not explicitly disclose wherein the control means shifts a position to start playback of media data selected through the media data accepting means from a top of the media data by an amount of elapsed time to playback the multimedia template from time to start playback of a part.

Ishii discloses an image processing apparatus including modifying the plurality of items of moving-image data (media data) (Abstract). Ishii further discloses the modification includes adding or inserting a media data into another metadata during playing back, i.e. moving-image data mov1.mpg to mov5.mpg are sequentially played back, and mov3.mpg is modified into the moving-image data mov1.mpg to mov5.mpg, and the mov3.mpg is modified moving-image data only a portion where the where the wipe effect has been applied from the time one second (elapsed time) before the end of mov2.mpg to the time one second (elapsed time) after the start of mov4.mpg (page 4,

paragraph [0059]], and this implies shifting a position of the mov3.mpg to 1 second to the mov2.mpg.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Ishii with Sudoh and Iijima to include wherein the control means shifts a position to start playback of media data selected through the media data accepting means from a top of the media data by an amount of elapsed time to playback the multimedia template from time to start playback of a part for the purpose of controlling the presentation of image/media data.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chau Nguyen whose telephone number is (571) 272-4092. The Examiner can normally be reached on Monday-Friday from 8:30 am to 5:30 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Doug Hutton, can be reached at (571) 272-4137.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Chau Nguyen/  
Patent Examiner  
Art Unit 2176